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| 10/605,862 | 10/31/2003 | Steven Hubbard | GEPL.P-092 | 2861 |
| 43247 7590 04/22/2008 Marina Larson & Associates LLC re: lexan PO BOX 4928 DILLON, CO 80435 | | | EXAMINER ALEXANDER, LYLE | |
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In re application of

Hubbard et al..

Serial No. 10/605,862

Filed: October 31, 2003

For: TAGGING MATERIAL FOR POLYMERS, METHODS,
AND ARTICLES MADE THEREBY

DECISION ON
PETITION

This is a decision on the PETITION UNDER 37 CFR 1.181 TO WITHDRAW THE RESTRICTION REQUIREMENT filed December 18, 2007 requesting review and withdrawal of the restriction requirement mailed June 18, 2007 and made final in the office action mailed September 25, 2007.

On June 18, 2007 a four way restriction between method of identifying a polymer, method of using tagged polymer material, polymer material, and a data storage medium was mailed. Applicants traversed the requirement in the response filed July 17, 2007. The examiner repeated the restriction requirement in an office action mailed September 25, 2007 and made the restriction requirement final.

On December 18, 2007 the instant petition under 37 CFR 1.181 was untimely filed to formally request the withdrawal of the restriction requirement being more than 2 months from the mailing of the final restriction requirement in the office action of September 25, 2007. Nevertheless, the petition will be considered in the alternative under 37 CFR 1.444.

Applicant's position for the withdrawal of the restriction requirement is that the examiner has not shown that the separate groups are distinct nor undue burden will result.

DECISION

Sections 803, 806.05(d), 806.05(c), and 806.05(h) of the MPEP states:

803 Restriction - When Proper

Under the statute an application may properly be required to be restricted to one of two or more claimed inventions only if they are able to support separate patents and they are either independent (MPEP § 806.04 - § 806.04(i)) or distinct (MPEP § 806.05 - § 806.05(i)).

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If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.

806.05(d) [R-5] Subcombinations Usable Together

Two or more claimed subcombinations, disclosed as usable together in a single combination, and which can be shown to be separately usable, are usually restrictable when the subcombinations do not overlap in scope and are not obvious variants.

> To support a restriction requirement where applicant separately claims plural subcombinations usable together in a single combination and claims a combination that requires the particulars of at least one of said subcombinations, both two-way distinctness and reasons for insisting on restriction are necessary. Each subcombination is distinct from the combination as claimed if:

(A) the combination does not require the particulars of the subcombination as claimed for patentability (e.g., to show novelty and unobviousness), and

(B) the subcombination can be shown to have utility either by itself or in another materially different combination.

See MPEP § 806.05(c). Furthermore, restriction is only proper when there would be a serious burden if restriction were not required, as evidenced by separate classification, status, or field of search.

Where claims to two or more subcombinations are presented along with a claim to a combination that includes the particulars of at least two subcombinations, the presence of the claim to the second subcombination is evidence that the details of the first subcombination are not required for patentability (and vice versa). For example, if an application claims ABC/B/C wherein ABC is a combination claim and B and C are each subcombinations that are properly restrictable from each other, the presence of a claim to C provides evidence that the details of B are not required for the patentability of combination ABC.

Upon determining that all claims directed to an elected combination invention are allowable, the examiner must reconsider the propriety of the restriction requirement. Where the combination is allowable in view of the patentability of at least one of the subcombinations, the restriction requirement between the elected combination and patentable subcombination(s) will be withdrawn; furthermore, any subcombinations that were searched and determined to be allowable must also be rejoined. If a subcombination is elected and determined to be allowable, nonelected claims requiring all the limitations of the allowable claim will be rejoined in accordance with MPEP § 821.04. <

806.05(c) [R-5] Criteria of Distinctness Between Combination and Subcombination

To support a requirement for restriction between combination and subcombination inventions, both two-way distinctness and reasons for insisting on restriction are necessary, i.e., there would be a *>serious< search burden >if restriction were not required< as evidenced by separate classification, status, or field of search. See MPEP § 808.02.

The inventions are distinct if it can be shown that a combination as claimed:

(A) does not require the particulars of the subcombination as claimed for patentability (to show novelty and unobviousness), and

(B) the subcombination can be shown to have utility either by itself or in another materially different combination.

When these factors cannot be shown, such inventions are not distinct.

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In the June 18, 2007 office action, the examiner stated that Group I claims 1-22 are drawn to a method of identifying a polymer, Group II claim 23 drawn to a method using a tagging material, Group III claims 24-68 drawn to a polymer material, and Group IV claim 69 drawn to a data storage method. Examiner then continues by stating that Group IV and Groups I,II,III are related as subcombinations usable in a single combination, Groups I and II,III are related as combination and subcombination, and Groups III and II are related as product and process of use.

Petitioner argues that i) Group IV claim 69 is a species of Group III and as such they must be examined together ii) the examiner's basis for maintaining the restriction requirement is incorrect as none of the groups outlined by the examiner are so related as subcombinations and combinations; and thus has not established that such are indeed distinct inventions and that no undue burden exists for searching as all contain similar limitations, and iii) Petitioner further states Group II is a species of generic claim Group I and that such must be examined together.

With regards to arguments i),ii) and iii), it is clear that Group IV and Group III and likewise Group II and Group I are distinct inventions while a species is a differing embodiment of a distinct invention see MPEP 806.04(e) and a genus is per MPEP 806.04(d) " a generic claim should require no material element additional to those required by the species claims, and each of the species claims must require all the limitations of the generic claim". Thus it is clear that Group IV is not a species of Group III and Group II is not a species of Group I as the proposed species each require additional limitations not required by the proposed generic claims. Claim 69 requires storage medium including a polycarbonate having a perylene which is not required by claim 24 of a polymer including a tagging material. The limitations of a storage medium and a polymer having a tagging material are not required by each separate group. Similarly Claim 23 of Group III is to a method of identifying a polycarbonate with a perylene while Group I is a method of identifying a polymer with a fluoro dye. Thus again Group III requires additional limitations not found within Group I.

Moreover, the Groups have been properly identified as subcombinations and combinations usable together. Claim 69(Group IV) requires a perylene not required by the combination of Group III. This is evidence that the combination as claimed does not require the specifics of the subcombination claim 69. On its face, this requirement appears to meet the necessary criteria for restriction as set forth in the cited MPEP section above.

In regards to the undue burden issue, it is noted that a search for the independent and distinct inventions while overlapping may not necessarily be coextensive and that the issues for examining the independent and distinct inventions outlined above, requiring undue burden in both search and examination.

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In view of the above discussion, having weighed both the examiner's position and the applicants' arguments, it is concluded that, on the balance, the restriction requirement is proper.

The petition is DENIED.

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